

## **Remarks**

Applicant respectfully submits the following remarks in response to the Office Action.

### **I. Claim Rejections – 35 U.S.C. § 102(a)**

Applicant respectfully traverses the Examiner's rejection of claims 1, 2, 4, 6, 10-13, 15, 17, 21, 22, 23, 25, 27, 31-34, 36, 38, 42, 43, 45, 46, and 48 under 35 U.S.C. § 102(a) as being unpatentable over Falconer (6,832,957), because Falconer lacks two important features of the invention as claimed in each of the amended claims. First, even prior to amendment the present invention disclosed a bonus indicator. Falconer discloses a plurality of games in a base or primary game, none of which are properly construed to be a bonus indicator. Second, the bonus indicator of the amended claims of the present invention is a separate, non-identical, simultaneously operating bonus indicator. For each of these reasons, Falconer does not anticipate any of the above listed claims, as amended.

As the Examiner correctly notes, "Falconer discloses, in Figures 1A and 1B and in the specification a gaming apparatus and method of playing comprising a plurality of games which operate independently of and simultaneously with each other, for approximately the same duration." (Office Action at 2). Applicant respectfully disagrees, however, with the Examiner's next statement that "[a]ny of the games 56 can be designated as a 'primary game' or a bonus indicator', as there is no particular structure to a primary game or a bonus indicator which is not read on by the Falconer disclosure." (*Id.*).

Falconer discloses a gaming device having a plurality (three) sets of identical reels that are played simultaneously by the player. The player may play multiple play lines on the three sets of identical reels in the primary game.

The gaming device disclosed and claimed in Falconer is a primary game only. None of the three sets of identical reels are a separate bonus game or indicator. Claim 1 of Falconer, its only independent claim, makes clear that each of the "plurality of sets of reels" disclosed and claimed are part of the primary game.

1. A gaming device having a primary game comprising:  
a plurality of sets of reels, each set of reels having a plurality of reels;  
a plurality of symbols which are identical on each of said sets of reels;  
a plurality of paylines associated with each of said sets of reels, wherein . . . .

(Falconer, claim 1) (emphasis added).

The Falconer specification is entirely consistent with this interpretation. The very first line of the Summary of the Invention in Falconer states: "The present invention provides a gaming device having a plurality of identical sets of reels for a base or primary game wherein ...." (*Id.*, Col. 3, ll. 14-16) (emphasis added). "The present invention includes the base or primary game (described below) being multiple identical games coordinated simultaneously during ordinary game play." (*Id.*, Col. 4, ll. 40-43).

A bonus game, as disclosed in Falconer, is a game separate and distinct from the primary or base game. "The gaming device of the present invention may also include any bonus triggering events, bonus games as well as any progressive game coordinating with the base game." (*Id.* Col. 4, ll. 49-51) (emphasis added). "In addition to winning base game credits, the gaming device 10, including any of the base games disclosed above, may include one or more bonus games that give players the opportunity to win credits. Bonus games include a program that automatically begins when the player achieves a qualifying condition in the base game. The gaming device may also employ a video-based central display device 30 or 32 for the bonus

game." (*Id.* Col. 6, ll. 36-43). In Falconer, it is the three sets of reels of the primary game that operate simultaneously and for approximately the same duration, not a bonus indicator.

In contrast, Applicant claims two separate elements as the invention: (1) a primary game; and (2) a bonus indicator separate from and not identical to said primary game that operates simultaneously with and for approximately the same duration as the primary game. The separately claimed bonus indicator is not a part of the primary game. As can be seen from Figure 1 and Figure 2 of the application the bonus indicator 103 is separate and distinct from the primary game 101. This separate and distinct bonus indicator, as originally claimed, is markedly absent from the Falconer game having multiple sets of identical reels in a primary game.

But, even if one of the sets of reels in the Falconer primary game were to be considered a bonus indicator, the applicant's claims, as amended, are patentably distinct for a separate, independent reason. Namely, the applicant's separate, simultaneously operating bonus indicator is not identical to the primary game.

The plurality of sets of reels in the Falconer game are identical. These identical sets of reels are an important aspect of Falconer. As stated in the specification, "[b]ecause the sets of reels are identical, the gaming software is less complex and the player can readily determine how, where and why the player has won." (Falconer, Col. 3, ll. 24-26). "It is therefore an advantage of the present invention to provide a gaming device having multiple identical sets of reels." (*Id.*, Col. 4, ll. 5-7).

The claims of the present application have been amended to make clear that the bonus indicator is not a set of reels that is identical to the set of reels in the primary game. Independent claims 1 and 11 now claim:

a bonus indicator separate from and non-identical to said primary game, said bonus indicator to operate simultaneously with said primary game, to be of approximately the same duration as said primary game, and to indicate whether a player goes on to a bonus round [or has won a prize in claim 11] .

Independent claims 22 and 32 now claim:

automatically initiating a separate, bonus indicator, said bonus indicator to operate simultaneously with and be non-identical to said primary game, to be of approximately the same duration as said primary game, and to indicate whether a player goes on to a bonus round [or has won a prize in claim 32].

The separate bonus indicator of the present invention is not identical to the primary or base game, as the plurality of sets of reels (which the Examiner contends can comprise both a primary game and a bonus indicator) are in Falconer. This is also shown in Figure 2 of the present invention, which discloses a primary game 101 and a bonus indicator 103, with indicia 105, that are different from the indicia of the primary game. Applicant has made this amendment to each of the independent claims of the application, and the amendment is therefore applicable to all the dependent claims as well. For example, claim 6 claims the apparatus of claim 1, wherein said primary game contains a plurality of reels and wherein said bonus indicator is one or more reels. Claim 6 could, prior to amendment, have been read to include elements of a primary game and a bonus indicator that were three identical sets of reels. After amendment, however, claim 6 incorporates claim 1 which precludes the bonus indicator being identical to the primary game. This is true for all of the dependant claims because all depend from an amended independent claim.

An anticipatory reference under § 102 must contain each and every limitation of the claims it anticipates. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). For the reasons set forth above, the separate, distinct, non-identical bonus indicator of amended independent claims 1, 11, 22 and 32 of this invention, and all the other claims which depend therefrom, is not taught or disclosed by Falconer, and the applicant respectfully requests that the Examiner withdraw the rejection.


**2. Claim Rejections – 35 U.S.C. § 103**

The Examiner rejected claims 3, 5, 14, 16, 24, 26, 35 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Falconer in view of Cannon because Falconer discloses all of the limitations of the claims with the exception of the bonus indicator being a roulette type reel. As set forth above, however, Falconer does not disclose the separate, non-identical, simultaneously operating bonus indicator limitation of the applicant's claims. Therefore, applicant respectfully requests that this rejection be withdrawn.

For the same reason, the Examiner's rejections of claims 7-9, 18-20 and 39-41 as unpatentable over Falconer in view of McClinitic and of claims 44 and 47 as unpatentable over Falconer in view of Cole should be withdrawn as well.

The applicant believes that all claims are now in condition for allowance and requests reconsideration.

Respectfully submitted,

  
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